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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,656

11/24/2006

Toru Masatomi

71,051-026

6287

27305

7590

07/30/2009

HOWARD & HOWARD ATTORNEYS PLLC  
450 West Fourth Street  
Royal Oak, MI 48067

EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,656	<b>Applicant(s)</b> MASATOMI ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/21/06 IDS.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                                    |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application                          |
| Paper No(s)/Mail Date <u>11/21/06</u> .  | 6) <input checked="" type="checkbox"/> Other: <u>Machine translation of JP 10-101765</u> . |



### **DETAILED ACTION**

1. The Applicants' preliminary amendments filed December 27, 2005 and May 1, 2006 are acknowledged. Claims 2-3, 5-6 and 8-9 are amended. Claims 10-21 are added. Now, Claims 1-21 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1 (lines 13-15), 5 (line 2), 12 (line 2) and 13 (line 2), it is not clear as to what "types" and/or "type" refer to.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 8-14, 16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP765 (JP 10-101765).

JP765 discloses a composition comprising a vinyl polymer derived from a monomer mixture containing vinyl monomer represented by formula (a) where R<sup>1</sup> can be methacryloxypropyl group, n is 0 and m is 3,  $\gamma$ -(meth)acryloxypropyltrimethoxysilane, etc., and alkyl (meth)acrylates in the presence of an azo-based initiator; a condensation catalyst such as an organotitanium compound, an organoaluminum compound, etc.; a solvent; and alkoxysilanes such as  $\gamma$ -aminopropyltri(m)ethoxysilane, etc. ([0006], [0012]-[0029]-[0033], [0050], [0052]-[0054] and Examples) Since the alkoxysilanes read on the claimed coupling agents, Examiner has reasonable basis to believe that JP765's alkoxysilanes can function as coupling agents.

6. Claims 1-2, 5-6, 8-9, 12-14, 16 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP668 (JP 04-103668).

JP668 discloses a composition comprising a polymer derived from a monomer mixture containing monomers (a)-(e). Monomer (a) can be  $\gamma$ -(meth)acryloxypropyltrimethoxysilane, etc., optionally (meth)acryloxyalkyl tris(trialkylsiloxy)silane, Monomer e) can be an alkyl (meth)acrylate. Monomer d) can be (meth)acryloxypropyl tris(trimethylsiloxy)silane in the presence of an azo-based initiator. (page 3, upper left column to lower left column, page 5, upper left column, page 6, lower columns, page 7, lower right column and Examples) A curing catalyst such as aluminum, titanium or zirconium compound and a solvent can be employed. (page 7, upper right column and page 8, all columns) The English translation of JP668 has been ordered by Examiner. It will be available to Applicants later upon request.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP765.

JP322 discloses a composition, *supra*, which is incorporated herein by reference. JP322 is silent on the pencil hardness of the cured coating film. However, since the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

9. Claims 7, 15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP668.

JP668 discloses a composition, *supra*, which is incorporated herein by reference. JP668 is silent on the pencil hardness of the cured coating film. However, since the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the

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reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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klp

July 23, 2009

/Kuo-Liang Peng/

Primary Examiner, Art Unit 1796